

Remarks

The examiner has rejected claims 1-12 under 35 U.S.C. §103 as being obvious by Stoot in view of Huang.

The examiner's official action initially identifies the second reference as being Koren. However, the details of the rejection indicate that the second reference is Huang. The examiner identifies the second reference by the name Huang and the description of such is unquestionably the Huang patent. Also, the Koren reference is cited in the additional prior art references.

Stoot discloses a sighting device for an archery bow. The sighting device consist of two framing arms which are mounted to a stabilizer arm.

Huang discloses a laser sight for use in archery wherein a laser is mounted to the middle portion of the bow.

Applicant's invention is an archery bow sight adapted for use with an archery bow having a handle and two oppositely disposed limbs comprises a bow stabilizing bar extending forwardly from the handle, a laser, and a mounting bracket for mounting the laser to the stabilizing bar so as to direct a laser beam forwardly from the bow. With this construction, the laser is mounted to the stabilizing bar so as to direct a laser beam in a direction generally along a portion of the path of an arrow propelled by the bow.

Applicant respectfully submits that it is improper to combine the Huang reference with the Stoot reference. The Stoot patent is solely based on the concept of having two upright arm mounted to the bow which act as a sighting device. As these arms are the sighting device this patent obviously does not show the need for a "second" sighting device, such as a laser, to be coupled to the first sighting device. Furthermore, it would not make sense to combine this first type of sighting device with a second type of sighting device as this would merely create confusion as to which device is correct and to which device the archer should utilize to sight the target.

Moreover, should the examiner's position be predicated upon removing the arms and replacing such with the laser device, Applicant submits that this also is improper. In order to do so there must be some motivation or suggestion by the references. Obviously, Stoot would not motivate or suggest one to depart from the clear teaching of the patent and replace the essential element of the inventive concept (the arms) with a totally different type of sighting system that has nothing whatsoever to do with the teachings of the patent and the use of the arms illustrated therein. To make the combination suggested by the examiner would destroy the intended use of the novel device and clearly go against its teachings, which suggest that the references actually teaches away from Applicant's claimed invention.

Similarly, the Huang reference clearly teaches that the laser is mounted to the stock of the bow. The device has several adjustment means that allow the device to be moved somewhat and aligned. This type of laser sighting device was specifically referred to by the Applicant in its BACKGROUND OF THE INVENTION. Applicant pointed out that "laser bow sights have typically been mounted to the handle portion of the bow, as shown in U.S. Patent Nos/ 4,606,629 and 5,495,675." The Applicant then pointed out the problems associated with the type of mounting system, see page 2, lines 17-26, which included difficulty in mounting, movement, misalignment, marring of the bow, and bow flexing associated problems. The Huang patent does not recite or contain anything that would motivate or suggest that one depart from the clear teachings of mounting the device directly to the bow.

Applicant's unique mounting of the laser sight upon the highly specific element of an archery stabilizing bar has overcome these problems associated with the mounting of the laser upon a "frame" mounted to the bow. Neither reference cited by the examiner suggest or motivate one to combine a laser device with the stabilizing bar to create a new type of archery sighting device. As neither reference suggest such a modification the examiner's combination of the references should not be allowed.

It is well settled that the obviousness of an invention cannot be established by combining the teaching of the prior art absent some teaching, suggestion or incentive supporting the combination, see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *Pentec, Inc. v Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed.Cir. 1985). Moreover, the mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art fairly suggests the desirability of the modification, see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the references do not suggest any motivation for, or the desirability of, Applicant's unique construction of the laser sighting device on the stabilizing bar. As such, it is improper to utilize these references to establish obviousness.

It is acknowledged that the tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP 2142. This is "especially important in the case of less

technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'". *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). With this in mind, a hindsight-based obviousness analysis must be supported by evidence which is "clear and particular". *In re Dembiczak*. It is insufficient to simply offer a broad range of sources or to make **conclusory statements**, as "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'". *Id.* Applicant respectfully submits that the examiner has claimed the present invention to be obvious utilizing hindsight, speculation and conclusory statements which are not, in fact, supported by the cited references, to come up with a combination that would either destroy the clear intention of the reference or modify such in a manner that goes against the clear teachings of the reference. Furthermore, it is submitted that it is only through such hindsight that the Applicant's invention can be gleaned from the cited references. Applicant respectfully contends that the invention is not obvious, but instead is novel and therefore worthy of patent protection.

It is believed that the application is in condition for allowance. An early notice to such effect is accordingly solicited.


Respectfully submitted,



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